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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 160

STRATEGICAL DEMOLITION TORPEDO COMPANY, INC.,

Petitioner,

vs.

THE UNITED STATES

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

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No. 160

STRATEGICAL DEMOLITION TORPEDO COMPANY, INC.,

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THE UNITED STATES

PETITION FOR WRIT OF CERTIORARI TO REVIEW JUDGMENT OF THE COURT OF CLAIMS

The petitioner respectfully shows to the Court, as follows:

Summary and Statement of Matter Involved

1. This matter involves a claim for compensation for infringement and use of a patented device belonging to petitioner. That prior to December 30, 1930, Joseph Barraja-Frauenfelder, William C. Magee, John H. Thomas, and Philip P. Krug were the true, original, first, and joint inventors of a certain new and useful improvement in a Strategical Demolition Torpedo not known or used by others in this country before their invention or discovery thereof, nor patented or described in any printed publica-

tion in this or any foreign country before their invention or discovery thereof, or more than two years prior to their application for patent in this country therefor, nor patented in any country foreign to the United States on an application filed by them, or their legal representatives, or assigns, more than twelve months prior to said application for patent in this country, and not in public use or on sale in this country for more than two years prior to their said application for patent in this country; and so being the true, original, first and joint inventors thereof, the said Joseph Barraja-Frauenfelder, William C. Magee, John H. Thomas, and Philip P. Krug made due application according to law for letters patent of the United States therefor, the said application being known and designated as Serial Number 505,654 filed December 30, 1930, renewed January 15, 1934, with request that if and when allowed, said patent be issued to plaintiff herein, and on the 21st day of August, 1934 upon the inventors' said application, and in conformance to law, Letters Patent in the name of the United States of America, dated August 21, 1934, No. 1,971,102, duly executed and recorded, sealed with the seal of the Patent Office and signed by the Commissioner of Patents, were duly granted to plaintiff herein pursuant to assignments executed to it for valuable consideration, whereby there was granted and secured unto plaintiff for a term of seventeen years from and after the 21st day of August, 1934 the exclusive right to make, use, and vend, throughout the United States and the territories thereof, the invention aforesaid, a description whereof in the words of the said inventors, was given in the schedule annexed to said Letters Patent and made a part thereof, and that petitioner is now the owner of the entire right, title, and interest in and to said letters patent, and to all rights of action, claims

and demands whatsoever for compensation for infringement and use thereof.

2. That the invention covered by and claimed in said letters patent No. 1,971,102 was not invented or discovered by petitioner, nor any of its assignors, while employed by the Government of the United States except that portion of the invention or discovery attributable to John H. Thomas, who at the time of the said invention or discovery was an employee of the Government of the United States. Neither your petitioner, nor any of its officers, directors, or stockholders, is now in the employ, or service of the Government of the United States.

3. Petitioner alleged in its petition below that the United States through its Navy Department under the Department of Defense did, since to wit, April, 1949, without the license or consent of petitioner and its assignors, use, infringe, and appropriate, and is now appropriating using and infringing the Strategical Demolition Torpedo contained in each of claims of said letters patent No. 1,971,102.

4. That the said unlawful use by defendant of petitioners' patent has resulted in great damages and loss, the amount of which is unknown but which will be shown at a trial of its case. The invention secured by said letters patent is of great utility and value to defendant.

5. The defendant below moved to dismiss the action brought by petitioner on the ground that the action is barred under 28 U. S. C. 1498.

Statute Involved

The statute involved is Section 1498 of the Judicial Code, 28 U. S. C. 1498, 63 Stat. 102, and the applicable provisions thereof relative to the questions here for review are as follows:

"Whenever an invention described in and covered by a patent of the United States is used or manufactured by or

for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the Court of Claims for the recovery of his reasonable and entire compensation for such use and manufacture.

* * * * * * *

"This section shall not confer a right of action on any patentee who, when he makes such a claim, is in the employment or service of the United States, or any assignee of such patentee, and shall not apply to any device discovered or invented by an employee during the time of such employment or service. June 25, 1948, c. 646, 62 Stat. 942, amended May 24, 1949, c. 139, 87, 63 Stat. 102."

Questions Presented

1. Was the lower Court in error in granting the motion to dismiss before it had heard evidence as to the contributions and experiments and ideas of the three co-applicants, Joseph Barraja-Frauenfelder, William C. Magee and Philip P. Krug?

2. Can the application of the above mentioned parties for letters patent and the granting of a patent thereunder, be held null and void because another applicant thereunder was under a disability by virtue of said Statute?

3. If the statute is silent as to other applicants who join with a Government employee in making application, was the lower Court correct in reading into the statute their disqualification?

4. Was the Court correct in denying the motion by assuming, without proof upon the part of the defendant, that the device was discovered or invented by an employee of the United States during his Government service?

5. Was the Court correct in holding that the interest of the co-inventors are indivisible?

6. Was the Court correct in denying the remaining three-fourths interests in said patent from prosecuting the suit, when such parties never were in the employ of the Government?

7. Was the ruling of the Court in violation of the Fifth Amendment to the Constitution of the United States?

Reasons Relied On for Allowance of the Writ

The writ should issue for the following reasons:

1. Under Rule 38 5(c) and Rule 41 of this Court it is submitted here that the Court below decided a question of general importance and a question of substance relating to the construction or application of a statute of the United States, which has not heretofore been settled by this Court and should be settled by this Court.

2. There are no cases decided by any Court under this statute covering the questions here presented, save the decision of the Court below, in which the Chief Judge, filed a dissenting opinion as shown by the transcript of record filed herein.

3. The Court in granting the motion to dismiss assumed certain facts, which were not pleaded in the petition, e.g., it based its construction of the statute on such supposed facts as: " * * * if one of those who put their ideas together to produce the invention was having the benefit, during the gestation of the invention, of the skills and tools and ideas available in a Government shop". The petitioner was entitled to take proof on its petition in order to show the facts as to how the invention was created, and, as stated in the dissenting opinion of the Chief Judge the motion to dismiss should have been overruled and the facts obtained. At least it should have been overruled with the right to renew it after taking of evidence and upon final hearing of the case.

4. The statute provides that it shall not apply to any device discovered or invented by an employee during the time of such employment or service of the United States. It is clear that the statute extends only to a Government employee and not to the other three applicants who never were in Government service, and whose ideas, skill, and knowledge may have been the sole factors in granting the patent. The proof may very well show that Thomas only put his name on the application and had contributed nothing toward the invention. If so, should the other applicants be prevented from suing the Government merely because Thomas at the time was employed by the Government? We submit that the statute is not that far-reaching, and if it had contemplated a denial to file suit to such employee and any others with whom he joined in an application, it would have been so expressly stated therein. The lower Court therefore, read into this statute a disqualification of the other three applicants. We submit this is reversible error.

5. The interests of co-owners of a patent are divisible and not indivisible. Were it not so, a patent would be issued to only one applicant and not to all applicants. A co-owner of a patent can assign his interest and could not do so, if the patent was indivisible. In *United States* v. *Burns,* 19 U. S. 246, this Court recognized the divisibility of property in a patent, and held that although one co-owner was under a disability by virtue of a statute, the other co-owner had the right to bring suit. Consequently the other three co-owners in the case at bar had the right to maintain the action in the Court below, the other co-owner being disqualified in participating in any recovery therein. The separability of the interests in patents of enemy aliens held jointly with United States citizens was provided for by Executive Order No. 9567, Section 2 (d), dated June 8, 1945.

6. In *Standard Oil Company* v. *Clark,* (C.C.A.N.Y. 1947, 163 Fed. 2d 917, certiorari denied 68 S. Ct. 901, 902, 333 U.S. 873, 92 L. Ed. 1149) the Court held, in effect, that the interest which American corporations obtained under agreement by which American and German corporations divided between themselves the beneficial rights of ownership outside of Germany of German corporation patents, were "property interests" of sufficient substance that American corporations could maintain suit under sub-section (a) of this section to recover them from Alien Property Custodian who had seized patents under section 1, etc., of the aforesaid Executive Order, as against the contention of the Custodian that they were merely "executory contracts."

7. That property rights in a patent held by different individuals are severable has been established beyond question by the Trading with the Enemy Act enacted by the Congress during the First World War, by the President's Executive Order issued thereunder during the Second World War, and by decisions of the Courts thereunder. By act of October 6, 1917, Chap. 106, 40 Stat. 411, as amended, in section 6, (c) thereof, the Congress provided as follows:

> "If the President shall so require any money or other property including (but not thereby limiting the generality of the above) patents, copyrights, applications therefor, and rights to apply for the same, trademarks, choses in action, and rights and claims of every character and description owing or belonging to or held for, by, on account of, or on behalf of, or for the benefit of an enemy or ally of enemy not holding a license granted by the President hereunder, which the President after investigation shall determine is so owing or so belongs or is so held, shall be conveyed, transfered, assigned, delivered, or paid to or may be seized by the Alien Property Custodian; and all prop-

erty thus acquired shall be held, administered and disposed of as elsewhere provided in this act."

8. It appears, from the authorities cited above, that the Courts bar recovery under a Statute only to such persons who specifically fall within the Statutory disability; and no case has been found where the contrary has been held. The Burns case and the Alien Property statutes quoted above deal specifically with patent rights or property in a patent and recognize the severability of the interests of co-inventors and co-owners for purposes of recovery by one co-owner where other co-owners may be barred. To the same effect is a statement in Section 219 of the Title "Patents", 69 Corpus Juris Secundum page 733, ". . . one part owner may not prejudice the rights of his co-owners, as by a release of the right to recover damages for infringement." In support of this statement is cited the case of *Lalance, etc. Manufacturing Co.* v. *Haberman Manufacturing Co.,* (C.C.N.Y. 93 Fed. 197). A statutory bar of the right to recover damages for an infringement is directly analogous to a voluntary release of such right in its implication as to co-owners or co-inventors of the patent.

9. The remaining three-fourths owners of the patent were summarily deprived of their property rights in the patent by the dismissal of the action. Their property has been taken without due process of law. The lower Court arbitrarily denied their right to introduce evidence as to their respective invention, and the source thereof and that the defendant was using their property without just compensation. The letters patent issued under said application filed by the four applicants for the new invention conferred upon the other three applicants, who are not under disability to sue the defendant, an exclusive property in the patented invention, which cannot be appropriated,

or used by the defendant, without just compensation, *James* v. *Campbell*, 104 U. S. 358; 26 L. Ed. 786.

It is, therefore, respectfully requested that the writ should issue in the case at bar, in order that equity and justice may be done.

Respectfully submitted,

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In the Supreme Court of the United States

OCTOBER TERM, 1951

No. 160

STRATEGICAL DEMOLITION TORPEDO COMPANY, INC.,
PETITIONER

v.

THE UNITED STATES

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

OPINION BELOW

The opinion of the Court of Claims (R. 6-10) is reported at 96 F. Supp. 315.

JURISDICTION

The judgment of the Court of Claims was entered on April 3, 1951 (R. 10). The petition for a writ of certiorari was filed on June 30, 1951. The jurisdiction of this Court is invoked under 28 U. S. C. 1255.

QUESTION PRESENTED

Whether the specific exception, with regard to claims by government employees, to the statutory privilege of suit for patent infringement against the United States, bars suit where one of four co-inventors was a government employee when the device was invented.

STATUTE INVOLVED

The pertinent provisions of Section 1498 of the Judicial Code, 28 U. S. C., Supp. IV, 1498, 62 Stat. 941, as amended, 63 Stat. 102 [1] are as follows:

> Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the Court of Claims for the recovery of his reasonable and entire compensation for such use and manufacture.
>
> * * * * *
>
> This section shall not confer a right of action on any patentee who, when he makes such a claim, is in the employment or service of the United States, or any assignee of such patentee, and shall not apply to any device discovered or invented by an employee during the time of such employment or service.

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[1] Formerly, Act of June 25, 1910, 36 Stat. 851, amended July 1, 1918, 40 Stat. 705, 35 U. S. C. (1946 ed.) 68.

STATEMENT

On December 30, 1930, four individuals who were the "first, and joint inventors" (R. 1) of a Strategical Demolition Torpedo applied for United States letters patent on their invention. They renewed their application on January 15, 1934, with a request that if their patent were granted, it should be granted to the Strategical Demolition Torpedo Company, Inc., the petitioner in this suit. The patent was granted to the petitioner on August 21, 1934. (R. 2.) On May 5, 1949, petitioner assigned the patent to the four original inventors but on May 20, 1949, the inventors reassigned the patent to the petitioner (R. 2-3).

On December 15, 1950, petitioner filed suit in the Court of Claims pursuant to Section 1498 of the Judicial Code alleging that the Navy Department was infringing its patent by using the patented device without consent of the petitioner and asked for just compensation for the alleged use (R. 1-5). Paragraph 6 of the petition (R. 3) stated that John H. Thomas, one of the inventors of the device covered by petitioner's patent, was an employee of the United States at the time of the invention or discovery. Respondent filed a motion to dismiss the petition on the ground that it was barred by the provision in 28 U. S. C. 1498 which says that the right to sue "shall not apply to any device discovered or invented by an employee" of the United States during the time of such employment and that the invention in question, the Strategical Demoli-

tion Torpedo, was invented by Thomas while he was such an employee (R. 5). The Court of Claims upheld respondent's contention, one judge dissenting, and dismissed the petition in a judgment rendered April 3, 1951 (R. 10).

ARGUMENT

In waiving the immunity of the United States to suit for patent infringement, Congress expressly provided that no right of action against the United States shall exist where the patented device was discovered or invented by an employee of the United States during his employment. Petitioner's effort to avoid the application of this exception derives from the fact that the suit here was brought by the assignee of four co-inventors, only one of whom was a government employee at the time the device was invented. We submit that the Court of Claims was clearly correct in dismissing petitioner's claim and that review by this Court is not warranted.

1. (a) Petitioner's main argument is that the exception to 28 U.S.C. 1498, *supra,* p. 2, extends only to government employees and thus does not preclude the other three inventors from bringing suit against the Government (Pet. 6). We believe that the scope of the statutory exception cannot be so limited.

The legislative history of the Act of 1910 (June 25, 1910, 36 Stat. 851, 35 U.S.C. (1946 ed.) 68) demonstrates that the statutory lan-

guage was deliberately employed to extend liability of the United States only for infringement of devices other than those with which a government employee had any association. In its original form, as first introduced in Congress, the Act contained only a blanket waiver of immunity on the part of the United States for patent infringement suits brought against it. The bill was severely criticized for its failure to contain a provision excepting suits brought by or on behalf of government employees, etc. During the course of the debate in the House, Representative Douglas declared (45 Cong. Rec. 8772):

> I submit that this bill ought on every account to be amended, so that *in no event* * * * *should the benefit of this act inure to any device which is invented while a man is employed by the Government.* [Emphasis supplied.]

To meet this objection, the amendment which is involved in the present case was added (45 Cong. Rec. 8785). This amendment (quoted *supra*, p. 2) does two things: (1) it preserves the Government's immunity with respect to suit brought either by any patentee who, when he makes such a claim, is in the employment or service of the United States, or by any assignee of such patentee; and (2) it provides that the Act shall not apply to any device discovered or invented by an employee during the time of his employment or service.

The broad purpose of this limitation was expressed by Representative Goldfogle of New York, who declared during the course of the debate (45 Cong. Rec. 8785):

> Mr. Chairman, the purpose of this amendment is to meet the objections that were justly urged to the bill, so far as government employees are concerned. Under the amendment it will not be possible to have the collusion or conspiracies to which references were made in the course of general debate. The amendment will shut out cases of employees who, availing themselves of experience gathered in the departments, have invented devices and then permitted the Government to use them, and therefore claim compensation from the Government.[2]

Petitioner's position clearly is in conflict with the fundamental purposes of the exception. Excluding a government employee from bringing suit for infringement by the United States of a device invented while he was an employee but permitting a private party to bring suit who was allegedly a joint inventor on the very same device, could afford

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[2] Representative Goldfogle continued: "But if the amendment be adopted, there will be still open a remedy to such employees. They can still come, as they now can come, before Congress, and lay their claims before us." This remedy is, of course, also available to the private inventors precluded from suit by the exception. On May 2, 1949, H.R. 4480, a private bill for the relief of Joseph Barraja-Frauenfelder, William Chamberlain Magee, John Henry Thomas and Phillip P. Krug, the four inventors of the Strategical Demolition Torpedo, was introduced in the 81st Congress, 1st Session (95 Cong. Rec. 5458) and referred to the Committee on the Judiciary.

opportunities for the collusion or conspiracies at which the amendment was aimed. A joint invention is the result of mutual contributions and united efforts of the parties. The culmination of the work is the result of each and all of the inventors, and no one may be a joint inventor unless he has had some share in the conception of the inventions.[3] *Shreckhise* v. *Ritchie,* 67 F. Supp. 926 (W.D. Va.), affirmed, 160 F. 2d 593 (C.A. 4); *Pointer* v. *Six Wheel Corporation,* 177 F. 2d 153 (C.A. 9). As the court below stated (R. 9), even if it held that the disqualification provided in the statute was applicable only to the extent that the government employee contributed to the invention, it would be fruitless to take proof as to how the invention was created, as urged by petitioner, because of the impossibility of apportioning to each inventor his contribution to an invention that is the product of all four inventors collectively. Petitioner would permit private parties, who were joint inventors with a government employee, to avail themselves of the experiences, ideas and contributions of the government employee, which may have been acquired because of that employee's

[3] Petitioner states on page 6 of its petition that "the proof may well show that Thomas only put his name on the application and had contributed nothing toward the invention." If this were true, petitioner's patent would be void as it is well settled that a patent issued on behalf of joint inventors, when in fact they are not joint inventors, is void. Walker on Patents, 6th ed., § 89; *Shreckhise* v. *Ritchie,* 67 F. Supp. 926. (W.D. Va.), affirmed, 160 F. 2d 593 (C.A. 4).

opportunities in his government position, in direct contradiction to the express purposes of the Act. The courts have strictly interpreted provisions relinquishing sovereign immunity.[4] *United States* v. *Sherwood,* 312 U. S. 584; *United States* v. *Shaw,* 309 U. S. 495. The construction for which petitioner contends would impose a liability on the Government not contemplated by the specific wording of the Act.

(b) Petitioner's second argument, that the interest of co-owners of a patent are divisible (Pet. 6), is immaterial to decision of this case. As the Court of Claims stated: "Whatever may be said about the indivisibility of a patent after it has been granted and has become a property right, we think that the invention, that is, the process of producing the idea to be patented, is indivisible in the strictest sense. It is not susceptible to dissection. * * * the culmination of the work, the invention itself when it was accomplished, was, according to the joint application for the patent, the accomplishment of each and all. Thus the device was 'invented by an employee' of the Government and cannot be the subject of a suit under Section 1498" (R. 9). Application of the statute to the facts here does not require decision as to whether the patent is

[4] This Court has held that the Act in question precludes recovery by a government employee where the invention was completed during his government service even though all the work on the invention was performed at the employee's home and during hours when he was not on government duty. *Moore* v. *United States,* 249 U. S. 487.

divisible but only whether the inventors, or their assignee, came within the exception of the Act.

Petitioner's related contention, that it is deprived of its property without due process of law (Pet. 8), merely begs the question. Petitioner has only such "property right" in its patent, at least so far as such "right" includes the privilege of suing the United States, as Congress has granted to it. Prior to the Act of 1910, patent owners had the right to sue the Government for infringement of its patents only under a theory of contract or implied contract.[5] *Belknap* v. *Schild,* 161 U. S. 10; *Schillinger* v. *United States,* 155 U. S. 163. The statute passed in 1910 was part of the patent laws of the United States, enlarging the rights of patent owners, and, as explained by the title of the statute, was "An Act to provide additional protection for owners of patents of the United States." Congress could impose such conditions on this additional grant of right as it saw fit. As has been demonstrated, petitioner is simply among the group of patent owners that Congress did not include in the statute passed in 1910.[6]

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[5] Neither theory is urged in the present case.

[6] Petitioner apparently believes that the application for letters patent by the four inventors and the patent granted thereunder are null and void because one of the applicants is under a disability by virtue of the statute involved (petition, page 4, question 2). This impression is erroneous. Both the application for letters patent and the patent itself are valid. The rights granted under the patent merely do not extend to the right to sue the Government for infringement.

2. Moreover, as petitioner cannot bring this suit as assignee of all four inventors, it is precluded by an established rule of patent law from maintaining the action. It is well settled that each of two or more co-owners of a patent is an indispensable party to an action in which infringement is charged and that the co-owners must sue jointly. *Bendix Aviation Corporation* v. *Kury,* 88 F. Supp. 243 (E.D.N.Y.); *Gibbs* v. *Emerson Electric Mfg. Co.,* 29 F. Supp. 810 (W.D. Mo.); *Rainbow Rubber Co.* v. *Holtite Mfg. Co.,* 20 F. Supp. 913 (D. Md.). Petitioner is the assignee of four co-owners of a patent and acquires the rights and limitations of each of the owners. Suit by a single owner would be subject to the defense of lack of the other owners as parties plaintiff, as they are indispensable parties to any action for infringement. Joinder of all owners as parties plaintiff would not be possible in this case as the owner who was an employee of the United States at the time of the invention is precluded by statute from an action against the United States. Petitioner, as assignee of the four inventors, is thus unable to sue as it cannot bring suit for infringement of the entire patent.[7]

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[7] It is clear that one co-owner of a patent right cannot compel the other co-owner to join in a suit for infringement and cannot make him a party defendant. *Gibbs* v. *Emerson Electric Mfg. Co., supra; Bendix Aviation Corporation* v. *Kury, supra;* Moore's *Federal Practice,* Vol. 3, pp. 2149, 2150. This may work a hardship on the part owner of a patent but it is an assumed hardship, as is the hardship on the three owners of the patent in the instant case who are

3. Petitioner states (page 5 of its petition): "There are no cases decided by any court under this statute covering the questions here presented, save the decision of the court below * * *." The statute was passed July 25, 1910, and has thus been in effect over 41 years. As this is the first case on this question arising under this statute in 41 years and as no similar cases are pending, it is submitted that this is not an important federal question requiring review by this court.

CONCLUSION

The decision below is correct, there is no conflict of decisions, and no question warranting review is presented. It is respectfully submitted that the petition for a writ of certiorari should be denied.

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AUGUST, 1951.

precluded from suit. This is well pointed out in *Rainbow Rubber Co.* v. *Holtite Mfg. Co.*, 20 F. Supp. at 916: "it is not in fact the court that is setting up the barrier to the actual plaintiff, the Rainbow Rubber Company, but the actual plaintiff has done this to itself by reason of its own voluntary action, to wit, its election to assume the status of a part owner merely of a patent, with the limitations and restrictions inherent in the law incident to such status."

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